Remarks

This amendment is responsive to the official action mailed December 21, 2005, and is accompanied by a Petition for Extension under 37 C.F.R. §1.136(a) and a charge authorization for the required fee for a three month extension.

The claims have been amended to more particularly and distinctly define the subject matter of the invention and to better distinguish from the prior art of record. No new matter is presented. The number of claims is unchanged.

The claims were rejected as anticipated under 35 U.S.C. §102 by US Pat. 6,519,571 – Guheen. Reconsideration is requested. The Guheen patent fails to meet applicant's invention claimed as a whole. Whereas Guheen does not meet all the aspects claimed, there is no bar to a patent presented under 35 U.S.C. §§102 or 103.

The claimed invention is a risk assessment tool whereby a service provider can assess the exposure of subjects, typically business entities, to certain risks of loss. In the preferred embodiments, the invention is directed to assessing the risks of losses of modern businesses, particularly losses that result from ignorance of arcane rules and recurrent pitfalls of the unwary. Applicant's has invented the technique of composing an "expert" assessment process having an inquiry/response interaction with the user, designed to detect and assess exposure to recurrent pitfalls that have legal, contractual and/or data processing aspects.

There is nothing disclosed or suggested in the Guheen reference that would enable a person of ordinary skill to practice applicant's claimed methods for assessing risk of loss, or that would lead routinely to modifying Guheen's disclosed techniques to strike out in directions other than those that Guheen has specifically disclosed. Guheen does not anticipate the claims because Guheen does not meet all the elements of applicant's claimed invention. See MPEP 2131. The differences between the invention and the prior art are such that the invention claimed as a whole is not shown to be obvious. Guheen has different objects, achieves them in different ways and produces a

different result, including the nature and form of output as compared to the claimed invention.

Applicant uses a composed set of pointed questions to elicit responses that enable assessment of the risk of losses. Claim 1 as amended states particularly and distinctly states that the assessment is one of potential losses. Dependent claims 5-7 particularly define sets of such losses in successively different claim scope. The categories stated in the dependent claims are losses associated with computational deficiency, denial of service, security breach, violation of legal regulations, tort, contractual breach, insufficient capacity to meet contractual requirements, breach of commitment of confidentiality, violation of intellectual property rights, and/or failure to adhere to multi-jurisdictional differences in regulation.

The claimed invention may be applied to the assessment of risk of losses that are potentially insurable, rendering the technique useful to providers of business insurance. The claimed technique is also useful as a business assessment technique in evaluations, or as a self-assessment technique for businesses that are interested in tightening up their operations proactively. However, the point is that the invention assesses risk of loss.

Dependent claims 2-4 and 8-10 particularly state that the method is practiced using a set of expert inquiries to process data respecting the user (or subject being assessed) so as to determine exposure to such losses by pointed expert inquiries. The responses of a user, as well as the collected responses of many users, can populate a database to enable improved processing and perhaps to improve the accuracy with which losses are related by the system to particular user situations as identified by the users' responses.

The cited patent to Guheen lacks a similar teaching or suggestion. In Guheen, an interface is to be produced so as to assist data processing interactions between a user and a set of data processing services. Guheen employs a database to represent the user, but that is where similarities between applicant's claimed invention and Guheen substantially ends.

Guheen selects a group of data processing or communication components to serve each user and arranges them in a hierarchy of units up to a tertiary level of cooperating functions by which data may be selected, processed and delivered to or for the user. The Guheen components can include vendor services and processing services that the user may require, and for which there are alternatives competing sources of certain types of services. Guheen produces a proposed or initial selection of a configuration of such components. By subsequent processing, Guheen improves the configuration of components by optimizing the selection to fit the particular user.

Guheen's technique may be effective in connection with designing a configuration or selecting among alternative configurations for as user interface that needs to deliver particular services. However this has little similarity with the objects of applicant's invention, or with the solutions that applicant has provided to solve the different problems that are encountered. Guheen is not concerned with risk. Guheen fails to suggest any applicability to risk of loss.

In the official action, the examiner has related passages in applicant's claims to portions of the disclosure of Guheen that are considered relevant. The step of interpreting user responses as indicating a predetermined level of risk is related to Guheen col. 2, lines 6-25. This referenced passage is the "Summary of the Invention" of Guheen's specification. The passage contains no implication or suggestion that there is any application of the subject matter of assessment of risk of loss:

> The present invention is provided for utilizing various types of user indicia such as search requests, products purchased, products looked at but not purchased, products purchased and returned, reasons for returning products, customers stated profile including income level, education level, stated profession, etc. for the purpose of customizing a user interface.
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> For example, the present system is capable of telling that the user was on the IT staff for an accounting firm and was reviewing software for purchase such that, when he drills down through product details on an ecommerce website, it would highlight first the software and hardware performance/requirements specs and next the return on investment. At a higher level, with the same customer, if he were searching for a word processor software, then the profile would present a review of the best software for accounting firms as written up in some accounting magazine. It might also compare what similar IT professionals from accounting firms purchased.

It is possible that Guheen's invention optimizes the operating systems available to the user and thus reduces that probability of users wasting potential opportunities for efficiency. However general purpose optimization techniques are not reasonably characterized as steps that assess and/or report on risks.

Applicant's claims particularly define the assessment of risks. In order to more clearly define over data processing techniques for optimization per se, as in Guheen, claim 1 has been amended more specifically to state that the risk areas encompass categories of potential losses. There is no basis to suggest that Guheen meets that invention defined in applicant's claims.

Regarding applicant's claims 2-4, the examiner refers to Guheen at col. 81, lines 30-60, which read as follows:

> Metrics are an important part of quality management in that they provide a method of measuring (for example, sampling, testing, and determining) whether a process or product meets a given criterion. With Metrics, different stakeholders can agree that a product objectively meets an expectation, or that a process has been improved by a measurable amount. Without Metrics, stakeholders can only have subjective opinions that may or may not agree.
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> Measurement tools are used to measure process quality and product quality. Process quality may include Metrics such as the time it takes to process a change request. Product quality should be measured for all the product expectations the project has set. This measurement process is the inspection part of quality management.
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> Statistical Process Control (152)
> Statistical Process Control tools are used to analyze the results obtained with the measurement tools. These display trends that can be used as the basis for process improvement or, in other cases, product rework.
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> Continuous Improvement (112)
> Continuous Improvement tools are used to analyze and improve the development processes.
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> Continuous Improvement is a process management technique by which action is taken to modify a process when the measurement or outcomes of that process are unsatisfactory. Process improvement is required whenever the number of defects exceeds the desired level, productivity falls below a desired threshold, or client expectations fail to be met. Once the process has been modified, it is remeasured to see whether the expected gain was actually achieved.

The foregoing passages likewise fail to suggest the possibility of an assessment of risk of loss. Guheen teaches at col. 81, lines 30-60 that it is possible by data processing techniques to apply measurements, including but not limited to statistical measurements, as a means to assess and improve development processes. There is

no reasonable objective teaching that there is any application of this idea to employing an interactive expert question-and-answer technique to determine a subject's exposure to any particular risks. Thus, claims 2-4 are also not anticipated or obvious from Guheen.

Regarding claims 8-10, the cited passage also does not suggest the possibility of serving pointed questions to the user as a means to obtain information. Applicant notes that Guheen teaches the analysis of user responses to identify the occurrence of keywords that have been previously associated with selections that the software might make to determine the optimal user profile. Even in that event, Guheen does not use the user's prompted responses to questions as a basis to glean such information. Referring to Fig. 69 and the associated description, Guheen teaches

> One embodiment of the present invention provides for comparison shopping by utilizing the customer's profile to prioritize the features of a group of similar, competing products, as shown in operation 1504 of FIG. 66. The competing products may or may not have been manufactured by competing business entities. More detail is provided in FIG. 68. First, in operation 1610, a customer's profile is developed. This profile may be developed from many sources including customer input, customer buying habits, customer income level, customer searching habits, customer profession, customer education level, customer's purpose of the pending sale, customer's shopping habits, etc. Such information may be input directly by the user, captured as a user uses the network, and may be downloaded periodically from a user's system. Next, in operation 1611, a plurality of items for purchase are displayed, from which the customer is allowed to select multiple, similar items, i.e. products or services to compare in operation 1612. Then, after a set of features of each item is determined in operation 1613, operation 1614 creates a hierarchy of the features of the items selected in accordance with the customer's profile.

This passage does not provide that the customer is asked to answer any sort of questionnaire designed to ask pointed questions leading into an expert assessment of risk of loss. There is no suggestion of analysis for risk of loss by any means. There is little or no teaching of how or why information might be collected by obtaining responses to a set of questions. On the contrary, the implication in the prior art reference is that the necessary information for defining a customer profile is to be determined indirectly from analysis of the customer's buying and data processing habits, and not directly from answers to questions designed specifically to glean risk information.

With respect to claims 9 and 10, the examiner refers to Guheen's mention of statistics at col. 81, lines 30-60 and suggests the limitations in these claims are inherent in the statistical process mentioned by Guheen. Reconsideration is requested.

Applicant's claims define a questionnaire with yes/no and numeric answer selections (claim 9); and wherein a failure of the user to answer a question is deemed a datum that is used in risk assessment (claim 10). The cited passage in Guheen, however, is entitled "Statistical Process Control" and says that statistical process control tools are used to analyze the results obtained with the measurement tools. There is no teaching in Guheen that there is information to be obtained about risk. There is no teaching of any statistical significance in risk assessment to use of both yes/no and numeric prompted user selections. There is absolutely no teaching that statistics can amount to measurement tools. On the contrary, Guheen discusses use of statistics to analyze data that was obtained by other measurements that are mentioned and do not resemble those claimed by applicant.

In all these respects, Guheen's disclosure does not meet the invention claimed. There is no basis to consider the reference to anticipate the invention. There is no basis to conclude that Guheen would render the invention obvious to a person of ordinary skill.

Guheen is concerned with a different object than applicant, namely optimizing an operating system for profiled user characteristics or preferences. Applicant is concerned with assessing risk of certain losses.

Guheen uses a different technique for collecting information to define the user profile. Guheen seeks dynamically to analyze the behavior of the user or customer. Applicant asks for user responses to pointed questions that in combination will reveal risk of loss.

Guheen's output is different from applicant's output. Guheen's "output" is a reorganization of options in a data processing system to conform to detected user characteristics. Applicant's output is an explanatory and corrective report that explains to the user where there is exposure to identified risks.

For these reasons, the prior art cannot be said to teach or disclose applicant's invention as a whole. A rejection under 35 U.S.C. §102 is unwarranted. Moreover, the only way that one can even arguably identify in Guheen abstracted similar ideas such as the use of statistics or some involvement of user selections or keystrokes, there is no incentive shown or remotely arguable that would lead a person of ordinary skill to modify Guheen in a manner that might lead to applicant's invention claimed as a whole.

The claims have been amended to more particularly define the invention and better to distinguish from the prior art. The differences between the invention and the prior art are such that the subject matter claimed, as a whole, is not shown to have been known or obvious. Therefore, the application is in condition for allowance. Reconsideration and allowance of claims 1-10 are hereby requested.

Respectfully submitted,

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